

Notice of Allowability

Application No.

10/603,953

Examiner

Robert Shiao

Applicant(s)

BORNMANN ET AL.

Art Unit

1626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to responses filed on 10/19, 2004.
2. ☒ The allowed claim(s) is/are 1, 4-5, 10, and 12, now are 1-5.
3. ☒ The drawings filed on 25 June 2003 are accepted by the Examiner.
4. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☐ All b) ☐ Some* c) ☐ None of the:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.
THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
 6. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO-1449 or PTO/SB/08),
Paper No./Mail Date _____
4. ☐ Examiner's Comment Regarding Requirement for Deposit
of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☐ Interview Summary (PTO-413),
Paper No./Mail Date _____
7. ☒ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____

DETAILED ACTION

1. This application claims benefit of the provisional applications: 60/277,116 with a filing date 03/19/2001.
2. Amendment of claims 1, 5, 10, and cancellation of claims 2-3, 6-9, 11, and 13-21 in the amendment filed on October 19, 2004, is acknowledged. Claims 1, 4-5, 10, and 12 are pending in the application.

Responses to Amendment

3. Since the limitation "tumors" of claim 10 has been incorporated, therefore, rejection of claim 10 under 35 U.S.C. 112, first paragraph, has been overcome in the amendment filed on October 19, 2004. Since claim 14 has been cancelled, therefore, rejection of claim 14 under 35 U.S.C. 112, first paragraph, is obviated herein.
4. Since the instant variable R⁵ of claim 1 does not represent OH or NHOH, therefore, rejection of claims 1, 4-5, 10, and 12 under 35 U.S.C. 102(b) or 103(a) has been overcome in the amendment filed on October 19, 2004. Since claims 2, 13-14, and 16 have been cancelled, therefore, rejection of claims 2, 13-14, and 16 under 35 U.S.C. 102(b) or 103(a) is obviated herein.

Reasons for Allowance

5. The following is an examiner's statement of reasons for allowance:
Claims 1, 4-5, 10, and 12 are neither anticipated nor rendered obvious over the art of record, and therefore are allowable. This invention relates to asymmetric

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synthesis of (S,S,R)-(-)actinonin and its analogs and uses therefor. The closest prior art is Davidsen et al. US 5,985,911, discloses C-terminal ketone inhibitors of matrix metalloproteinases and TNF α secretion. The difference between above reference and instant claims is that the instant variable R⁵ of the formula of claim 1 does not represent OH or NHOH. Suggestion for modification of above reference to obtain the instant compounds, processes of making, and methods of use has not been found. Claims 1, 4-5, 10, and 12 are allowed.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Shiao whose telephone number is (571) 272-0707. The examiner can normally be reached on 8:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph K. McKane can be reached on (571) 272-0699. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information

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for published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

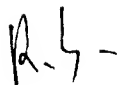
For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).



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Robert Shiao, Ph.D.
Patent Examiner
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12/13/04

December 13, 2004